

weight of diethylene glycol. Hosoi at page 2, line 52 to page 3, line 3. None of these layers includes, nor does Hosoi suggest for these layers, a layer that comprises ethylene terephthalate units as in the at least one outer layer of the invention.

Both layers (A) and (B) of Hosoi may furthermore contain a third component in total amount of less than 1% by weight in the layers. The listed examples of these third components include the following:

aromatic dicarboxylic acids such as
terephthalic acid, isophthalic acid, diphenylsulfonedicarboxylic acid,
4,4'-diphenyldicarboxylic acid and benzophenonedicarboxylic acid;
aliphatic dicarboxylic acids such as
succinic acid, adipic acid, sebacic acid and dodecanedicarboxylic
acid;
alicyclic dicarboxylic acids such as hexahydroterephthalic acid and 1,3-
adamantanedicarboxylic acid;
1,3-propanediol;
1,4-butanediol;
1,6-hexanediol;
neopentyl glycol;
1,4-cyclohexanedimethanol;
ethylene oxide adduct of bisphenyl A; and
p-xylylene glycol.

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Hosoi at page 3, lines 4-9.

If the Examiner believes that the present claims would have been obvious in light of a selection of terephthalic acid as a third component in layer (B) of Hosoi, applicants respectfully disagree for at least two reasons. First, even if one skilled in the art were to choose terephthalic acid as the third component, that choice would not result in the Hosoi film having ethylene terephthalate units. That is because the "ethylene" segment of the "ethylene terephthalate" unit would still be missing.

Second, Hosoi does not guide one skilled in the art to select terephthalic acid as the third component as opposed to any others. Terephthalic acid appears embedded within the overall list of examples of third components, and Hosoi does not explain why or under what circumstances one would choose any particular component over the other. The Hosoi Examples, moreover, do not guide this selection either. Indeed, none of the Examples contain the third component at all. In view of the absence of the required motivation to arrive at the claimed film

ingredients from the teachings of Hosoi, the inventive film would not have been *prima facie* obvious.

Hosoi also does not suggest the T_g2 relationship between the layers and overall film as is claimed. According to the claims, the T_g2 value of the film is above the T_g2 value of the base layer, but below the T_g2 value of the outer layer. This relationship is represented by the following: $T_{g2} \text{ (outer layer)} > T_{g2} \text{ (film)} > T_{g2} \text{ (base layer)}$. Hosoi does not guide one skilled in the art to the claimed polyester film having that relationship, and the Examiner has not explained how any "specific combination of strength, flexibility, and surface properties" identified in the Office Action would produce such a relationship, or how one skilled in the art would have known to choose those variables in a way to arrive at the claimed T_g2 values.

In any event, Hosoi would appear to teach away from the claimed T_g2 relationship. As noted above, the base layer of Hosoi comprises a layer (A) that consists essentially of recurring units of ethylene-2,6-naphthalenedicarboxylate. The layer (B) of Hosoi, on the other hand, is composed mainly of ethylene-2,6-naphthalenedicarboxylate with 1 to 5% by weight of diethylene glycol. One skilled in the art would expect T_g2 value for layer (B) to be lower than that of layer (A) due to the presence of diethylene glycol in layer (B), accomplishing the following:

$T_{g2} \text{ (base layer)} > T_{g2} \text{ (film)} > T_{g2} \text{ (outer layer)}$. This is opposite to the claimed order of $T_{g2} \text{ (outer layer)} > T_{g2} \text{ (film)} > T_{g2} \text{ (base layer)}$, and so does not suggest the claimed subject matter.

In view of the above, the claims are not *prima facie* obvious over Hosoi. Applicants therefore respectfully request that the Examiner withdraw this rejection.

III. Rejection under 35 U.S.C. § 103(a) over Hosoi with Ullmann's

The Examiner rejected claims 4-6, 13, 16, and 18-23 under 35 U.S.C. § 103(a) as unpatentable over Hosoi in view of Ullmann's Encyclopedia. Ullmann's does not supply any of the teachings missing in Hosoi that would have been needed to suggest the invention of claim 1. For example, Ullmann's does not help to form a suggestion of a film having at least one outer layer composed of at least 40% by

weight of ethylene 2,6-naphthalate units and also ethylene terephthalate units present in an amount up to 40% by weight. Ullmann's also does not help to form the T_g2 relationship of the claims of $T_{g2}(\text{outer layer}) > T_{g2}(\text{film}) > T_{g2}(\text{base layer})$. The Examiner has not argued that Ullmann's fills in any of these gaps. Instead, the Examiner appears to rely on Ullmann's only for teachings of certain features within the rejected dependent claims not subject to the first 103(a) rejection over Hosoi alone. Since the combination of Hosoi with Ullmann's does not suggest the subject matter of claim 1, the combination also cannot suggest claims 4-6, 13, 16, or 13-23, which depend either directly or indirectly from claim 1. Applicants therefore respectfully request that the Examiner withdraw this rejection.

In view of the above, the presently claimed invention stands patentable over the prior art. If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Steven J. Scott
Reg. No. 43,911

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